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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,105	12/12/2006	Wolfram Andersch	ANDERSCH=1	2886
1444 7590 12/31/2009 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
PACKARD, BENJAMIN J				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
12/31/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/555,105

**Applicant(s)**

ANDERSCH ET AL.

**Examiner**

Benjamin Packard

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' arguments, filed 9/16/09, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Petition Decision Noted - Finality of Prior Action Withdrawn***

Examiner notes a petition to vacate the Final Office Action mailed 8/21/09 was granted 10/21/09.

#### ***Claim Rejections - 35 USC § 103***

**Claims 1-6 and 8-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over teachings of Watanabe et al (WO 01/02378, see IDS dated 03/09/07) in view of Cullen et al (US 4,748,186, see 892 dated 6/16/08), and Assmann et al (US 6,277,791, see 892 dated 6/16/08).

Applicants assert claim 1 has been amended to require a "synergistic" composition and the prior art has no showing of such synergism. Further, Applicants assert the art does not teach the second agent provides the synergistic result or the narrowed genus of compounds recited in instant claim 12.

Examiner disagrees. First, Examiner notes that while claims 1 is directed to "a synergistically active pesticidal composition" where the second agent "synergistically enhances said one or more active pesticide compounds of group 1", it is noted that a

composition in of itself is not "synergistic", but the application of the same produces "synergistic effects", as suggested in the second half of the claim limitation. That said, Watanabe et al specifically teaches that the active compound may be used in a mixture of active components for the purpose of widening the activity spectrum and preventing the development of resistance. Where, such an effect occurs, a synergistic effect would be obvious, and is even suggested in the prior art (page 8 lines 23-28) where the ability of the combinationed active agents attack pests through a wider spectrum of activity than individual compounds. Assmann et al further supports this position by teaching the addition of multiple active compounds to pesticides are known to have synergistic effects (id.). Thus, the synergistic effect instantly claimed is not an unexpected result, given the teachings of the prior art which makes such a result expected.

Further, even if Examiner were to view the working examples of the instant specification (pgs 33-41) as showing of unexpected results beyond what is expected in the prior art, the specific combinations are limited to tefluthrin, aldicarb, clothianidin, imidacloprid, tebufospyr, and IIA in combination with the compound IC (see pg 9 of instant specification), and such combinations are not commensurate in scope of the instant claims.

Second, Applicant's assertion of nearly infinite possible combinations is unfounded where the primary compound instantly claimed is the same primary compound taught in Watanabe et al, and the variation only comes in selection of the secondary agent from the specifically disclosed secondary components. The selection would then only require the selection of the secondary agent. Thus the combination is

not overly burdensome and the testing would simply require mixing the various compounds and testing with an expectation of success, where the result is a pesticide composition with a widened spectral of activity.

Finally, with regards to new claim 12, Watanabe et al, (pg 12 line 27 and pg 14, line 13) further teaches the addition of spinosad at one of the suggested secondary components to add to the composition with the specifically disclosed primary compound. As previously discussed, it would have been obvious to one of ordinary skill in the art to pick and choose from among the disclosed compounds, specifically disclosed in the prior art and taught to be combined with the primary compound for the purpose disclosed in the prior art, i.e. to produce a nematocidal composition.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Packard whose telephone number is 571-270-3440. The examiner can normally be reached on M-R 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin Packard/  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612